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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,307	09/12/2006	Denis Pasquet	1107-060442	3388
83690	7590	04/13/2009		
Baker Botts L.L.P. 30 Rockefeller Plaza New York, NY 10112				
EXAMINER				
YANG, ANDREW				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
04/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,307

**Applicant(s)**

PASQUET ET AL.

**Examiner**

ANDREW YANG

**Art Unit**

3775

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, line 6, "the direction" lacks a prior antecedent.

In claim 16, line 8, "the inside face" lacks a prior antecedent.

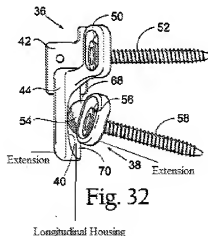
***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. (U.S. Publication No. 2003/0028250) in view of Zucherman et al. (U.S. Patent No. 5836948).

Reiley et al. discloses an intervertebral implant comprising a spacer having a body with a top end face 36 and a lower end face 38 opposite the top end face. The top end face 36 has a groove 42 wherein the groove comprises a first side and a second side. The first and second sides of the groove each have an opening (Figure 20). The lower end face 38 has a longitudinal housing extending orthogonally to the groove 42 and formed on a bottom end face of lower part 38 as seen in the figure below.



The implant can be implanted between the fifth lumbar vertebra and the sacral vertebra (Paragraph 20) where in a top portion will be in the longitudinal housing (Figure 38). It is noted that the illustrated figure does not show the sacral vertebrae, however, a top portion of the lower vertebrae in figure 38 is in the longitudinal housing.

Reiley et al. also fails to disclose that a strap having a first end passed into the first opening and a second end passed into the second opening. Zucherman et al. teaches an interspinous implant 20 having a groove 26 for receiving a spinous process that has a tether 31 passed into openings on the side faces of the groove 26 (Figure 2). The tether 31 can pierce the process or go around it. It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Reiley et al. with a strap connected at the holes on the side of the grooves for attachment to a spinous process in view of Zucherman et al. Substituting one known means of attachment o a spinous process for another, would have been obvious to one skilled in the art.

### ***Response to Arguments***

In response to Applicant's argument that Reiley fails to disclose a longitudinal housing extending orthogonal to the groove, the Examiner respectfully disagrees. A housing as defined in Merriam-Webster dictionary is something that covers or protects, an enclosure, or a support for mechanical parts. The member 44 extends longitudinally down from the groove and is perpendicular to it. The concave portion of the member forms a housing since it can be considered a portion that covers or a support for

mechanical parts. The concave portion extends along member 44 and thus is also perpendicular to the groove. In regard to the use of the device, as stated before, the intended use of a device does not define over prior art if the structural limitations have been met.

In response to Applicant's argument that it would not have been obvious to one skilled in the art at the time the invention was made to combine the references of Reiley and Zucherman, the Examiner respectfully disagrees. Applicants contend that substituting the strap of Zucherman for the rod of Reiley would not have been obvious. Both Reiley and Zucherman disclose spinal implants that have a groove portion for receiving a spinous process. Thus substituting known fixation means for one another would have been obvious. Applicants further contend that the substitution would not have yielded predictable results since Reiley requires a rigid fixation. The rigid fixation of Reiley is obtained by pedicle screws 52. Furthermore, as stated in paragraph 80, the rod 48 is optional, thereby showing that member 48 is not relied upon for rigid fixation. Therefore, using a strap to secure the spinous process within the groove would have yielded predictable results of maintaining the spinous process within the groove.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW YANG whose telephone number is (571)272-3472. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on (575)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Yang/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775